R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

SUPPORT FOR THE CLAIM AMENDMENTS

Support for the claim amendments may be found in the specification, for example, on page 4 lines 17-19, page 5 lines 13-15, page 6 line 16-page 7 line 5, page 14 lines 7-15, FIGS. 1-2, as originally filed, and the Microsoft Computer Dictionary (Fifth Edition) conventional definition of a programmable logic device on page 425. Thus, no new matter has been added.

PROVISIONAL DOUBLE PATENTING REJECTION

The provisional rejection of claim 1 over claim 1 of co-pending Application No. 09/992,652 has been obviated by the attached Terminal Disclaimer and should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

The rejection of claims 1, 3, 5, 9-11, 13, 15, 19 and 20 under 35 U.S.C. §102(b) as being unpatentable over Winter et al. '862 (hereafter Winter) has been obviated in part by appropriate amendment, is respectfully traversed in part, and should be withdrawn.

Winter concerns a method of forming an integrated circuit (Title).

Claim 1 provides a step for generating a programming item from a plurality of parameters that define a program for customizing a programmable logic device, the programmable logic device being configurable by a customer using the programming item after manufacturing has been completed. In contrast, column 2, lines 53-55 of Winter appears to concern simulation, formation and testing of integrated circuits. One of ordinary skill in the art would not appear to understand simulating and formation of an integrated circuit to take place after manufacturing has been completed. One of ordinary skill in the art would not appear to understand testing of an integrated circuit to configure the integrated circuit. Furthermore, a programmable logic device may be a type (species) of integrated circuit (genus), as mentioned on page 7 of the Office Action. However, an integrated circuit does not necessarily anticipate a programmable logic device per MPEP §2131.02. Therefore, Winter does not appear to disclose or suggest a step for generating a programming item from a plurality of parameters that define a program for customizing a programmable logic device, the programmable logic device being configurable by a customer using the programming item after manufacturing has been completed as presently claimed. Claims 11 and 20 provide language similar to claim 1.

Claim 1 further provides a step for storing the programming item in a programming field of the file suitable for programming the programmable logic device. Assuming, *arguendo*, that the hexadecimal values and decimal values of Winter are

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similar to the claimed programming item (for which Applicants' representative does not necessarily agree), Winter appears to be silent regarding a plurality of parameters used to generate the hexadecimal and decimal values. Claims 11 and 20 provide language similar to claim 1. Therefore, the Examiner is respectfully requested to either (i) identify the parameters of Winter allegedly used to generate the hexadecimal and decimal values or (ii) withdraw the rejection.

Claim 1 further provides a step for storing at least one of the parameters for customizing the programmable logic device in a non-programming field of the file. In contrast, the READ INPUT ON PORTH term in Winter does not appear to be a parameter according to the definition supplied on page 3 of the Office Action. In particular, READ INPUT PORTH does not appear to be "a value that is given to a variable, either a the beginning of an operation or before an expression is evaluated by a program." Assuming, *arguendo*, that READ INPUT PORTH is a parameter (for which Applicants' representative does not necessarily agree), Winter appears to be silent regarding use of the READ INPUT PORTH parameter for customizing the alleged programmable logic device. Winter does not appear to use READ INPUT PORTH in generating any programmable data that is suitable for customizing any device and/or circuit. In contrast, READ INPUT PORTH appears to be nothing more than a comment used to make the program easier for a human to understand. Claim 11 provides language similar to claim 1. Therefore, the Examiner is respectfully requested to either (i)

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identify where Winter discusses using the READ INPUT PORTH "parameter" in customizing an alleged programmable logic device or (ii) withdraw the rejection.

Claim 11 further provides a structure comprising a storage medium and a computer program. In contrast, Winter appears to be silent regarding the claimed combination of storage medium and computer program. Therefore, Winter does not appear to disclose or suggest a structure comprising a storage medium and a computer program as presently claimed. As such, claim 11 is fully patentable over the cited reference and the rejection should be withdrawn.

Claim 20 further provides a means for storing at least one of the parameters used for generating the programming item in a non-programming field of the file. Despite the assertion on page 7 of the Office Action, the term READ INPUT ON PORTH does not appear to be a parameter used for generating a programming item that defines a program for configuring an programmable logic device. In particular, the READ INPUT ON PORTH term appears to be merely a comment used to make the program easier for a human to understand. Therefore, Winter does not appear to disclose or suggest a means for storing at least one of the parameters used for generating the programming item in a non-programming field of the file as presently claimed. As such, claim 20 is fully patentable over the cited reference and the rejection should be withdrawn.

Claims 3, 5, 9, 10, 13, 15 and 19 depend from either claims 1 or 11, which are now believed to be allowable. Since the

dependent claims contain all of the limitations of the independent claims, claims 3, 5, 9, 10, 13, 15 and 19 are fully patentable over the cited reference and the rejections should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 2, 4, 6-8, 12, 14 and 16-18 under 35 U.S.C. §103(a) as being unpatentable over Winter in view of Muller et al. '630 (hereafter Muller) is respectfully traversed and should be withdrawn.

Winter concerns a method of forming an integrated circuit (Title). Muller concerns a method and apparatus for a multi-gigabit Ethernet architecture (Title).

Winter has a US classification of 395/500 while Muller has a US classification of 370/556. Based on the US classifications, Winter and Muller are non-analogous art. Therefore, *prima facie* obviousness does not appear to exist as both Winter and Muller would not be available to one of ordinary skill in either art. As such, the claims are fully patentable over the cited references and the rejection should be withdrawn.

One of ordinary skill in the art would not appear to have any motivation to make the proposed combination mentioned on page 10 of the Office Action. In particular, storing a frequency parameter of Muller in a non-programming field of a file from Winter does not appear to permit Winter's system to "allow the transfer rate of data to exceed the network traffic of 1 Gbps." No nexus appears to exist between storing a frequency parameter in an

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integrated circuit formation file and establishing a high transfer rate on a network. Winter does not even mention a network, so the alleged motivation appears to be merely a conclusory statement. Therefore, *prima facie* obviousness does not exist to combine/modify Winter and Muller. As such, the claims are fully patentable over the cited references and the rejection should be withdrawn.

Claim 7 provides that a cyclic redundancy check checksum is configured to detect a bit swap within the file. Despite the assertion in the Office Action, column 14, lines 9-12 of Muller appear to be silent regarding a bit swap:

> Individual bit errors that result in the corruption of a packet's data will be detected and handled at the MAC level (e.g., by a CRC computation) after re-assembly of mini-frames by a collector.

Nowhere in the above text, or in any other section does Muller appear to mention a bit swap. Therefore, Winter and Muller, alone or in combination, do not appear to teach or suggest that a cyclic redundancy check checksum is configured to detect a bit swap within the file as presently claimed. As such, claim 7 is fully patentable over the cited references and the rejection should be withdrawn.

Claim 17 provides that the non-programming field is disposed in a first portion of the file, the programming item is disposed in a section portion of the file and the cyclic redundancy check checksum is disposed in a third portion of the file. In contrast, both Winter and Muller appear to be silent regarding a file having the three claimed portions. Therefore, Winter and

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Muller, alone or in combination, do not appear to teach or suggest that the non-programming field is disposed in a first portion of the file, the programming item is disposed in a section portion of the file and the cyclic redundancy check checksum is disposed in a third portion of the file as presently claimed. As such, claim 17 is fully patentable over the cited references and the rejection should be withdrawn.

Claims 2, 4, 6, 8, 12, 14, 16 and 18 depend from either claims 1 or 11, which are now believed to be allowable. Since the dependent claims contain all of the limitations of the independent claims, claims 2, 4, 6, 8, 12, 14, 16 and 18 are fully patentable over the cited references and the rejections should be withdrawn.

Claim 21 depends from claim 20, which is now believed to be allowable. As such, claim 21 should be allowed.

INFORMATION DISCLOSURE STATEMENT

Applicants' request (i) consideration of the IDS filed on February 6, 2004 and return of the submitted PTO-1449 form signed by the Examiner, (ii) consideration of the IDS filed on August 18, 2004 and return of the submitted PTO-1449 form signed by the Examiner and (iii) consideration of the IDS filed on November 15, 2004 and return of the submitted PTO-1449 form signed by the Examiner. Copies of the February 6, 2004, the August 18, 2004 and the November 15, 2004 PTO-1449 forms are available on the PAIR system.
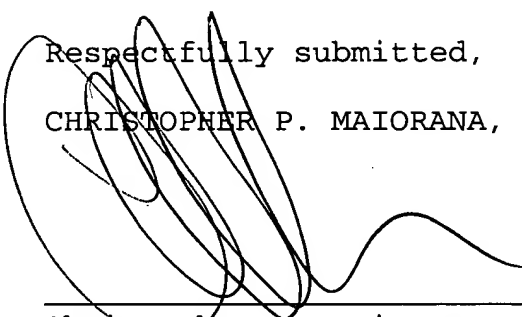
·Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicants' representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 50-0541.

Respectfully submitted,

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